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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,335	11/14/2000	Bjorn Markus Jakobsson	30-6	8563
7590 03/01/2005 Ryan Mason & Lewis LLP 90 Forest Avenue Locust Valley, NY 11560			EXAMINER GURSHMAN, GRIGORY	
			ART UNIT	PAPER NUMBER
			2132	
DATE MAILED: 03/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/712,335

Applicant(s)

JAKOBSSON ET AL.

Examiner

Grigory Gurshman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Referring to claim 15, the rejection under 35 USC § 101 is withdrawn in view of Applicant's amendment of the instant claim.
2. Referring to claims 1-15 Applicant argues that *prima facie* case of obviousness has not been established because Harrison and Akiyama collectively fail to teach an encryption key associated with a time interval. Examiner respectfully disagrees and points out that, according to Harrison, the key is generated for the particular set of files (see Fig.1) and the key is used in accordance with the preset time limit (see block 6). Therefore the encryption key is associated with the time interval, as recited in the instant claims.
3. Applicant further argues that rejection contains no objective evidence of record that would motivate one skilled in the art to combine the references applied. Examiner also disagrees and point out that one of ordinary skill in the art would have been motivated to have a software program configured to encrypt files with the key associated with the time interval and provide periodic updates including encryption keys associated with subsequent time intervals as taught in Akiyama for eliminating a risk of the unlawful decryption thereof by a third party (see Akiyama column 17, lines 66-68). The objective evidence is found in teachings of Harrison and Akiyama accordingly.
4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight

reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. Applicant points out some differences between prior art of record and the claimed invention. Examiner points out that none of the alleged differences are reflected in the independent claims 1, 14 and 15.

### ***Drawings***

6. The formal drawings filed on 12/10/2004 are accepted by examiner.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison (U.S. Patent No. 5,870,468) in view of Akiyama (U.S. Patent No. 5,784,464).

9. Referring to the instant claims Harrison discloses enhanced data privacy for portable computers (see abstract and Fig.4). Harrison teaches a method for protecting selected files in a portable computer system. With this invention a user selects a set of files on a hard disk of the system for protection. This invention uses an encryption key,

a secret key and an algorithmic transform to protect the selected files. With this invention the selected files are encrypted with the encryption key, and two copies of the encryption key are scrambled, one with the secret key and one with the transform of the secret key (see abstract and Fig. 1).

10. Referring to the independent claims 1, 14 and 15, the limitation "configuring the software program ... such that one or more files generated by the program are at least partially encrypted using a first cryptographic associated with a current time interval ..." is met by file protection agent software (18) depicted in Fig. 2, which encrypts files with encryption key. The key is generated for the particular set of files (see Fig.1) and the key is used in accordance with the preset time limit (see block 6). Therefore the encryption key is associated with the time interval, as recited in the instant claims.

While Harrison teaches the use of a second encryption key, he does not explicitly teach providing periodic updates of the encryption key associated with a subsequent time interval.

Referring to the instant claims, Akiyama teaches that the contents of a variety of titles that are managed by the service provider system 1 are encrypted beforehand with the respective keys KG.sub.1j. It is required that the encryption be re-performed by periodically updating the title keys KG.sub.1. As a premise of this process of FIG. 14, it is assumed that the second master key (KM2) 185 of the key management unit 18 is absolutely identical with the second master key (KM2) 163 of the key update processing unit 16. Further, the title key KG.sub.1j used once is to be disposed of without reusing it, and, hence, the second master keys 163, 185 used for generating the title key

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KG.sub.1j are changed each time the key is updated. In the next step S45, the key update timer 17 waits a certain time limit (e.g., after midnight on every Sunday) and then changes over the respective SW1, SW2, SW4, SW5 (see column 17, lines 63-67 through column 18, lines 1-20). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have a software program configured to encrypt files with the key associated with the time interval of Harrison and provide periodic updates including encryption keys associated with subsequent time intervals as taught in Akiyama. One of ordinary skill in the art would have been motivated to have a software program configured to encrypt files with the key associated with the time interval and provide periodic updates including encryption keys associated with subsequent time intervals as taught in Akiyama for eliminating a risk of the unlawful decryption thereof by a third party (see Akiyama column 17, lines 66-68).

11. Referring to claim 2, Harrison shows that files encrypted with the first encryption key are decryptable by programs having a corresponding decryption key (see Fig. 6).

12. Referring to claim 4, Harrison also teaches the use of a secret key, which meets the limitation "symmetric cryptographic key".

13. Referring to claim 5, Akiyama teaches that one encryption key is produced from the second key by using the one-way function (see column 17, keys generated from the master key).

14. Referring to claim 7, Harrison shows that the time interval defined by the idle timer (33) is uniquely associated with the encryption key (3) – see Fig. 5.

15. Referring to claim 10, Harrison teaches that the files are encrypted with the interval of the idle timer, thereby providing the compatibility of the versions of encryption keys as shown in Fig. 6.

16. Referring to claim 11, Akiyama shows the use of network for distributing content for the server to the client (see Fig.2)


17. Referring to claims 12 and 13, it is well known in the art to provide software updates in an automatic manner as well as to use identifiers associated with the number of legitimate copies. One of ordinary skill in the art would have been motivated to provide software updates in an automatic manner as well as to use identifiers associated with the number of legitimate copies in order to avoid the use of software by unauthorized parties.

### ***Conclusion***

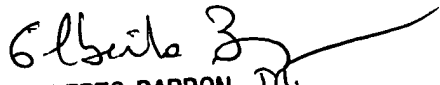
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GG

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